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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------|-----------------------------|------------------------|
| 10/700,226 | 11/03/2003 | David William Froesel | 7371 | 3104 |
| Paul M. Denk Suite 170 763 S. New Ballas Rd Saint Louis, MO 63141 | | | EXAMINER CHIU, RALEIGH W | |
| | | | ART UNIT 3711 | PAPER NUMBER |
| | | | MAIL DATE 07/31/2009 | DELIVERY MODE PAPER |

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID WILLIAM FROESEL

Appeal 2009-005061
Application 10/700,226
Technology Center 3700

Decided:¹ July 31, 2009

Before TONI R. SCHEINER, LORA M. GREEN, and
RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 3, 5, 6, 8-12, and 14, all the claims pending. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The invention is directed to “a washer toss game . . . having goals or boxes that are integrally formed, but which can be manipulated to furnish a greater challenge to the participants” (Spec. 2).

Independent claim 14 is representative of the subject matter on appeal:

14. A washer toss game comprising an integrally molded polymer box incorporating side walls, a base integrally molded with the side walls, an upstanding centrally arranged sleeve, said sleeve being integrally formed with the base, said sleeve having an opening therein sufficiently to accommodate the insertion of a container therein during usage, a container for inserting within the said sleeve, said container capable of being removed from said polymer molded box, said centrally disposed container is formed of metal, said polymer molded box is polygonally shaped, the polymer molded box includes a series of integrally formed side walls, and the game base, the diameter of each metal container is approximately greater than five inches, and the diameter of the integrally formed central sleeve for the box is slightly greater than the diameter of said container to accommodate its insertion and removal therefrom, whereby upon participating in the game, the user tosses a washer at the box in an effort to obtain their entrance therein, and particularly into the centrally disposed metal container.

The Examiner relies on the following evidence:

| | | |
|------------|--------------|---------------|
| Blume, Sr. | US 4,392,653 | Jul. 12, 1983 |
| Geror | US 5,882,010 | Mar. 16, 1999 |
| Bour | US 5,909,877 | Jun. 8, 1999 |

The Examiner rejected the claims as follows:

- Claims 3, 5, 6, 8, 12, and 14 under 35 U.S.C. § 103(a) as unpatentable over Geror and Blume, Sr.²
- Claims 9-11 under 35 U.S.C. § 103(a) as unpatentable over Geror, Blume, Sr., and Bour.

We affirm.

ISSUE

The dispositive issue in both rejections is the same: Has Appellant demonstrated that the Examiner erred in concluding that a washer toss game comprising an integrally molded polymer box and a centrally located insertable metal container would have been obvious, given the disclosures of Geror and Blume, Sr.?

FINDINGS OF FACT

FF1 Claim 14, the only independent claim, is directed to a washer toss game comprising:

(1) a polymer box with integrally molded side walls, a base, and an upstanding, centrally located sleeve with an opening capable of receiving a container; and

(2) a metal container which can be removably inserted in the upstanding centrally located sleeve.

FF2 The metal container can be “something akin to or similar to a quart paint can” (Spec. 2-3).

FF3 Claim 9 depends indirectly from claim 14 and requires reinforcing ribs in the base of the polymer box. Claim 10 depends from

² The Examiner included claim 13 in this rejection, but according to Appellant, claim 13 has been canceled (App. Br. 3).

claim 9 and requires that the base accommodate the “the insertion of a nail therein to affix the polymer molded box to the ground during usage.”

Geror

FF4 Geror describes a washer toss game having a target component “conveniently constructed as an integral, one piece plastic molding” (Geror, col. 2, ll. 8-10).

FF5 While a thermoplastic target is preferred, Geror teaches that the target may also be constructed of wood or metal (*id.* at col. 2, ll. 30-33).

FF6 Figures 1 and 2 of Geror, reproduced immediately below, show top perspective and top plan views of Geror's integrally molded target 10:

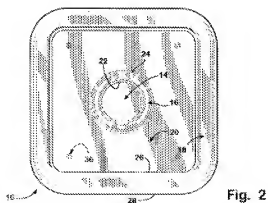
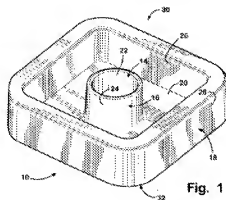


Figure 1 is a top perspective view of the target 10, while Figure 2 is a top plan view of the target.

FF7 As illustrated in Geror's Figures 1 and 2, "[t]he target has a generally centered cup with a base and upstanding sidewalls. Perimeter target sidewalls are spaced outward from the cup sidewalls. A tray portion extends between the cup sidewalls and the perimeter target sidewalls" (*id.* at col. 1, ll. 32-36).

FF8 Also as shown in Figure 2, "a set of four counter sunk holes through the tray portion 20 may be optionally provided as anchors 36, for use with flat head screws, nails, spikes, or other fasteners, depending upon surface material to which the target 10 may be fastened" (Geror, col. 2, ll. 36-40).

Blume, Sr.

FF9 Blume, Sr. describes a washer toss game similar to Geror's, but with two separate components - a box assembly and an insertable tubular member. The components of Blume, Sr.'s game are illustrated in Figure 1, reproduced below:

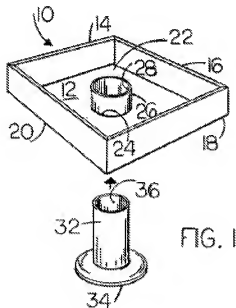


Figure 1 of Blume, Sr. shows a square shaped box assembly 10 with a bottom wall, sidewall portions, a centrally located opening 24 and “a tubular portion 26 extending upwardly therefrom The tubular portion 26 defines a target member having a chamber 28 therein for receiving and holding playing pieces when tossed therein” (Blume, Sr., col. 1, l. 68 to col. 2, l. 4). “An insertable tubular receiving member 32, usually though not necessarily taller than the side walls . . . [and] having a flange portion 34 . . . is slidably positioned into telescopic engagement with the tubular target member 26 incorporated within the box assembly” (*id.* at col. 2, ll. 19-24).

FF10 “The insertable receiving member 32 also includes a chamber 36 therein for receiving and holding playing pieces when tossed therein and the overall height of the receiving member 32 determines the relative difficulty of the game” (Blume, Sr., col. 2, ll. 25-29).

FF11 Blume, Sr. teaches that the box assemblies may be made of lightweight, durable materials like plastic or wood, but does not discuss fabrication of the insertable receiving member 32 (Blume, Sr., col. 2, ll. 5-9).

Bour

FF12 Bour describes a lightweight, rigid plastic panel for a tossing game “composed of a lattice, honeycomb or like structure . . . formed by a series of crisscrossing ribs” together with “[p]eripheral reinforcing ribs . . . [and] a series of spaced, lateral reinforcing ribs” (Bour, col. 3, ll. 53-62).

PRINCIPLES OF LAW

“[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990).

In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007), the Supreme Court rejected a rigid application of a teaching-suggestion-motivation test in the obviousness determination. The Court emphasized that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418; *see also id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”). “[N]either the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim.” *Id.* at 419.

Finally, an “[e]xpress suggestion to substitute one equivalent for another need not be present to render such substitution obvious.” *In re Fout*, 675 F.2d 297, 301 (CCPA 1982).

ANALYSIS

Claims 3, 5, 6, 8, 12, and 14

The Examiner rejected claims 3, 5, 6, 8, 12, and 14 as unpatentable over the combined teachings of Geror and Blume, Sr.

The Examiner concluded that it would have been obvious “to place an insertable container within the upstanding sleeve of Geror in view of Blume in order to alter the difficulty of the game” (Ans. 3), and moreover, that it would have been obvious to use a metal insertable container because “select[ing] a known material on the basis of its suitability for the intended use [is] a matter of obvious design choice” (*id.*).

Appellant acknowledges that it is within the general skill of a worker “to know that products can be made of different materials” (App. Br. 9), but contends that, in this case, “the specific material used provides a greatly

enhanced result” (*id.*) “with respect to the audible aspects of this game” (*id.* at 8). Appellant contends that “differentiation of sounds may be generated” (*id.*) by inserting a metal container into the upstanding sleeve of the polymer box, “so that from a distance away, where the player tosses the washer, he/she can readily hear and determine when a bulls-eye has been met, or when just peripheral points have been obtained” (*id.*).

Appellant’s argument is not persuasive. Appellant does not identify an error in the Examiner’s conclusion that it would have been obvious to place an insertable container, such as the tubular member taught by Blume, Sr., into the upstanding sleeve of Geror’s molded box to vary the difficulty of the game. Rather, Appellant’s position is that it would not have been obvious to make the insert of metal and the box of polymer because nothing in the prior art addresses the audible aspects of such a choice of materials. However, Geror teaches that the targets can be made of polymer or metal (FF5). When constructing the target with two components in order to vary the difficulty of the game, a person of ordinary skill in the art, who is also a person of ordinary creativity, would have had reason to make the base and the insertable member from any of the conventional materials identified by Geror, in any combination, since the listed materials were explicitly taught as suitable for a washer toss game. Again, it is the objective reach of the claims that matters, rather than Appellant’s purpose or motivation. *See KSR*, 550 U.S. at 419.

Claims 9-11

The Examiner also rejected claims 9-11 as unpatentable over the combined teachings of Geror, Blume, Sr., and Bour.

The Examiner concluded that it would have been obvious “to provide reinforcement ribs beneath the Geror box in view of Bour in order to make the target lightweight, yet rigid” (Ans. 4).

Appellant contends that Geror’s molded box “is devoid of any reinforcement” (App. Br. 9), as required by claims 9-11, and that Blume, Sr. does not show any type of reinforcement structure either (*id.*).

This argument is not persuasive. The Examiner relies on Bour, not Geror or Blume, Sr., as disclosing a lightweight plastic game structure strengthened by reinforcing ribs (FF12), and Appellant has not pointed out any error in the Examiner’s proposed combination of Bour with Geror and Blume, Sr.

Finally, Appellant contends that Geror “does not show any means for accepting a nail or other securing device . . . so that the device may be fixed to the ground” (App. Br. 9) as required by claims 10 and 11.

This argument is not persuasive, as Geror explicitly teaches that the target has four counter sunk holes for use with nails or other fasteners “to facilitate affixing the target to a surface” (FF8).

CONCLUSIONS OF LAW

Appellant has not demonstrated that the Examiner erred in concluding that a washer toss game comprising an integrally molded polymer box and a centrally located insertable metal container would have been obvious, given the disclosures of Geror and Blume, Sr.

SUMMARY

- The rejection of claims 3, 5, 6, 8, 12, and 14 under 35 U.S.C. § 103(a) as unpatentable over Geror and Blume, Sr. is affirmed.
- The rejection of claims 9-11 under 35 U.S.C. § 103(a) as unpatentable over Geror, Blume, Sr., and Bour is affirmed.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

cdc

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